

DETAILED ACTION

RCE Acknowledged

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/11/2008 has been entered.

Status of Application

2. Acknowledgement is made of amendment filed on 08/11/2008. Upon entering the amendment, the claim 32 is newly added. Accordingly, claims 1-12, 17-32 and 39 are pending and presented for examination.

Response to Arguments

3. Applicant's arguments filed on 08/11/2008 have been fully considered but they are moot in view of new ground(s) of rejection due to scope changes made into newly amended claims. Upon further consideration, a new ground(s) of rejection is made as follows.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 7-8, 11-12, 17-20, 27-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention. The independent claim 1 does not recite any properties of cosmetic composition such as gloss, whiteness, transparency, brightness, compressibility or glint and it is unclear what constitutes the "increased gloss or increased whiteness or increase transparency or increase brightness or increased compressibility or glint as recited in claims (claims 7-8, 11-12, 17-20 and 31-32) . Increase in gloss or whiteness or --- is compared to what number or percentage of the cosmetic composition. These terms are not defined in the specification. An ordinary skill in the art would not apprise of the metes and bounds of what constitutes the "increased "properties of the cosmetic composition.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-12, 17-21, 23-24 and 27-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Fu (US 6,056,815).

Fu discloses a cosmetic composition comprising pearlescent pigment products containing platelet substrates including natural or synthetic mica particles coated with nacreous pigment titanium dioxide. And synthetic mica substrates include muscovite, phlogopite, and biotite, other sheet silicates, such as talc, kaolin or sericite particles. Mica particles sizes are preferably in the range of 5-400 micron as recited in the claim (see col. 2 lines 41-65+ and claim 2). Fu further discloses that the promising area of

application for this composition products are in areas such as cosmetics, food stuffs, and food contact applications, where tin free coatings are preferred (see col. 4 lines 46-50). Since the essential elements of the Fu cosmetic composition are identical to the instant composition (i.e. nacreous pigment, synthetic mica and particle size), the composition would inherently have the same physiochemical properties such as gloss, whiteness, compressibility, transparency, and brightness as the composition set forth in the instant application. (All these properties are inherent and vary with the composition of nacreous pigment e.g. see Defossez et al. US 5,486,354; Kimura et al. US 4,623,396). Thus the claims are readily envisaged by the teaching of the cited reference and the claims are properly included in the rejection.

Applicant's arguments filed on 08/11/2008 have been fully considered but they are not persuasive.

Applicant asserts that Fu does not teach a composition containing synthetic mica coated with nacreous pigment and particles having a size range from about 150-1000 microns.

This argument is found not persuasive since, Fu clearly teaches a composition comprising pearlescent pigment products containing platelet substrate (synthetic mica such as muscovite, phlogopite, and biotite) coated with titanium dioxide and particles having a size range of 5-400 microns (see col. 2 lines 45-51). And the composition products can be used in cosmetic field and food stuffs.

And applicant also asserts that inherency is not established by probabilities or possibilities, and the requirement of gloss, whiteness, transparency, brightness, compressibility or glint has not been met by reference.

Again this argument is not persuasive, since same composition should have same properties. Since Fu's composition is identical to the instant composition, wherein the synthetic mica particles having size range of 5-400 microns, coated with titanium dioxide would have similar properties of gloss, whiteness, transparency, brightness, compressibility or glint.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-12, 17-32 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu (US 6,056,815) and (XP 002001244, abstract only) in view of DeLuca, Jr. et al (US 6,626,989 B1).

Fu meets the claim limitation as stated above.

XP reference discloses a composition comprising synthetic mica (fluorophlogopite) having a particle size of 100-1000 microns coated with metal oxide (titanium dioxide). And the composition comprising the ornamental pigments can be used for paints, plastics, cosmetics etc. Further coated pigments look glossy from every angle and good whiteness degree.

Fu and XP reference fails to disclose the use the cosmetic composition for various cosmetic uses such as nail polishes, lipsticks, lip-gloss, and eye-mascaras ... as recited in claim 26.

DeLuca, Jr. et al. disclose a cosmetic composition comprising high quality titanium dioxide-coated micaceous pearlescent pigments. And muscovite mica is the preferred mica because of its white color, other micas can be used which include phlogopite, or synthetic micas (see col. 3 lines 55-60). And cosmetic composition can be used in the lip/eye area and for all external and rinse off applications. Thus, they can be used in lip gloss, lip rouge (cream), lipstick, mascara cake/cream, nail enamel, perfume lotion, pre-electric shave lotion, shampoos of all types (gel or liquid), shaving cream, skin glosser stick, skin makeup (liquid, pomade) sunscreen lotion, face powder (loose/pressed), eye shadow, eye liner, dusting powder, and the like (see col. 4 lines 33-60+).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the combination of synthetic mica particles coated with titanium dioxide for potentiation of pearlescent pigments and their use in cosmetic

compositions, as taught by Fu, combine it with the cosmetic compositions, as taught by XP reference and Deluca Jr. and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Fu teaches the potentiation of pearlescent pigment composition can be used in areas such as cosmetics, food stuffs, and food contact applications, where the tin-free coatings are preferred to meet government health and safety regulations.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

1. No claims are allowed at this time.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGADISHWAR R. SAMALA whose telephone number is (571)272-9927. The examiner can normally be reached on 8.30 A.M to 5.00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571)272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618

Jagadishwar R Samala
Examiner
Art Unit 1618

sjr